No. 79-330

In the Supreme Court of the United States

OCTOBER TERM, 1979

MASANAO MATSUI, ET AL., PETITIONERS

v.

LUTRELLE S. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

WADE H. MCCREE, JR.
Solicitor General
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Washington, D.C. 20530

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Petitioners contend that the Commissioner of Patents and Trademarks improperly refused to accord their patent applications a filing date of October 26, 1976. The petition merely repeats the essentially factual argument rejected by the courts below—that the application was substantially in compliance with the requirements of 35 U.S.C. 115. There is no reason for further review in this Court.

1. On October 26, 1976, a proposed application for a patent was submitted by an attorney for Rikagaku Kenkyusho, a Japanese company that was designated as the assignee of the patent. The proposed application included a declaration, executed by the attorney as agent for the company, which recited that the application was

based on certain Japanese patent applications (Pet. App. A-18, A-19). However, while the declaration identified the application as one of "Matsui, et al.," it did not contain a statement identifying the original and first inventor of the process, as required by 35 U.S.C. 115. In addition, the Japanese applications to which reference was made were not filed with the United States patent application and were not otherwise available to the Patent Office (Pet. App. A-23). Accordingly, the proposed application was not given an October 26, 1976, filing date because it was not complete (*id.* at A-20 to A-24). Two days later, petitioners submitted a proposed application that contained all the required parts, including a declaration by the inventors (*id.* at A-23 to A-24). An Assistant Solicitor of the Patent Office advised petitioners that "[c]onsideration will be given * * * to assigning a filing date of October 28, 1976, to the papers deposited on October 28, 1976, inasmuch as all parts of an application were on deposit as of said date" (*id.* at A-24).

Petitioners filed a complaint in the United States District Court for the District of Columbia seeking an order requiring the Commissioner to assign a filing date of October 26, 1979, to their application (Pet. App. A-25).[1] The district court granted summary judgment in favor of the Commissioner, holding that he had no authority to assign the requested filing date to an application that did not at that time conform to the statutory requirements (Pet. App. A-1 to A-2). The court of appeals affirmed (*id.* at A-3).

[1]Petitioners are concerned with the two-day difference in filing dates because they wish to take advantage of the previous filing of their Japanese patent applications. Under 35 U.S.C. 119, petitioners would be entitled to "priority" only if their United States patent applications were filed within one year of the filing of the foreign applications; the "priority period" expired on October 26, 1976 (Pet. 9).

2. Petitioners' argument that the Commissioner has confused a problem of "form" with a matter of "substance" in the application of the statutory requirements is insubstantial. The distinction proposed by petitioners is merely a reflection of their continued disagreement with the factual conclusions of the Commissioner. Those findings have been reviewed and upheld by two courts, and there is no reason for further review. See *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 275 (1949).

Petitioners are mistaken in their assertion that there is an intra-circuit conflict between this decision and the decision in *A.F. Stoddard & Co.* v. *Dann*, 564 F. 2d 566 (D.C. Cir. 1977). In *Stoddard*, the court of appeals ruled that a patent application that was complete on its face could be amended subsequently to correct an error. Nothing in *Stoddard* contradicts the established principle that the Commissioner has no authority to accept for filing an application that, as here, lacks one of the statutorily required elements.

A statutory oath or equivalent declaration that the applicant is the "original and first inventor or discoverer" is an essential part of a patent application. See 35 U.S.C. 111, 115; 37 C.F.R. 1.65. "No person has a vested right to a patent, but is privileged to seek the protected monopoly only upon compliance with the conditions which Congress has imposed." *Boyden* v. *Commissioner of Patents*, 441 F. 2d 1041, 1043 & n. 3 (D.C. Cir. 1971) (citation omitted). Since an inventor is not entitled to a patent unless he complies with these conditions, a proposed application will neither be given a filing date nor taken up

for examination until all of the requirements enumerated in 35 U.S.C. 111 have been met. *Gearon* v. *United States*, 121 F. Supp. 652, 654 (Ct. Cl. 1954).[2]

It is therefore respectfully submitted that th petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.
Solicitor General

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[2]In *Gearon* the court specifically found that an application could not be assigned a filing date before receipt of the oath required by 35 U.S.C. 115.

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